

ESTTA Tracking number: **ESTTA339912**

Filing date: **03/30/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050920
Party	Defendant Soni, Milena
Correspondence Address	Surjit P. Soni THE SONI LAW FIRM 35 N. Lake Ave.Suite 720 Pasadena, CA 91101 UNITED STATES surj@sonilaw.com, woosoon@sonilaw.com, ron@sonilaw.com
Submission	Opposition/Response to Motion
Filer's Name	Ronald E. Perez
Filer's e-mail	ron@sonilaw.com, lauren@sonilaw.com, woosoon@sonilaw.com, surj@sonilaw.com
Signature	/Ronald E. Perez/
Date	03/30/2010
Attachments	Intellect v Soni_Pleadings_Mot2DenyPetitionersMot2AmdPet_sps._final.pdf ( 8 pages )(37734 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTELLECT TECHNICAL	)	
SOLUTIONS, INC.	)	
	)	
Petitioner,	)	CANCELLATION NO.: 92050920
v.	)	
	)	
MILENA SONI	)	Reg. No. 3,009,990
	)	
Respondent.	)	
<hr style="border: 0.5px solid black;"/>		)

**RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE  
TO FILE AMENDED PETITION TO CANCEL**

**I. INTRODUCTION**

Petitioner, Intellect Technical Solutions, Inc., ("PETITIONER") has moved for leave to amend its Petition to Cancel, pursuant to Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.115 and TBMP § 507.02, to add an additional class to cancel and add additional grounds for cancellation for all classes in which the subject mark is registered. Respondent, Milena Soni, ("RESPONDENT") hereby opposes.

**II. STATEMENT OF FACTS**

In the original Petition to Cancel, PETITIONER sought to cancel RESPONDENT's mark in two classes, International Classes 35 and 41 on the ground of alleged prior use. Through the current

motion, PETITIONER seeks to amend its Petition to Cancel to include the remaining class of RESPONDENT's mark as well, International Class 44, to cancel RESPONDENT's mark in its entirety. Further, PETITIONER seeks to add additional grounds for cancellation, non-use and abandonment, for all three classes in which RESPONDENT's mark is registered.

As the basis for the adding new grounds for cancellation, PETITIONER relies on RESPONDENT's deposition testimony taken on February 9, 2010.

### **III. PETITIONER'S PROPOSED AMENDMENT IS FUTILE**

PETITIONER's motion is premised upon selective portions of RESPONDENT's deposition testimony. The deposition, when viewed *in toto*, does not support PETITIONER's contentions or claims. Permitting an amendment would result in undue delay of the proceeding, and the assertion of baseless and futile claims against RESPONDENT, causing prejudice to RESPONDENT.

A trial court may deny a motion to amend if permitting an amendment would prejudice the opposing party, produce an undue delay in the litigation, or result in futility for lack of merit. *Jackson v. Bank of Hawaii*, 902 F.2d 1385, 1387 (9th Cir. 1990); See *Foman v. Davis*, 371 U.S. 178, 182(1962)(listing these factors among others to be considered). Prejudice to the opposing party is the most important factor. *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 401 U.S. 321, 330-31(1971)(*emphasis added*) (the

trial court is "required" to take potential prejudice into account in deciding Rule 15(a) motion); 6 C. Wright, A. Miller & M. Kane, Federal Practice and Procedure: Civil 2d § 1487 (1990).

PETITIONER alleges that RESPONDENT revealed in her deposition that "the services provided in connection with the registered mark have been limited to referring persons to a third party for motivational assessment test. This is a self-serving misconstruction of the transcript of Mrs. Soni's deposition testimony. In fact, the allegation is starkly contradicted, rather than substantiated, by Mrs. Soni's testimony. Mrs. Soni testified that she offered motivational assessment testing, designed for providing the services in connection with the registered mark through agents. Mrs. Soni testified that the individual and business entity who administered the motivational assessment testing were doing so under an agreement that Surjit P. Soni entered, on behalf of RESPONDENT, with them. See Exh. A., page 9, lines 4-5, 12-25; page 10, lines 1-25.

Furthermore, contrary to PETITIONER's allegation, Mrs. Soni testified that she also discussed the test results with the clients who took the test or answered questions they had regarding the test results. See Exh. A., page 139, lines 5-17; page 140, lines 6-11; page 141, lines 1-5. RESPONDENT thereby demonstrated that she participated in 'personally' providing the services in connection with the registered mark.

PETITIONER also claims that it newly discovered that Mrs.

Soni's "only use of mark has been by word of mouth, on letterhead, and on business cards." That information has been already unambiguously disclosed in RESPONDENT's response to PETITIONER's First Set of Interrogatories, and should have been already within PETITIONER's knowledge. Moreover, RESPONDENT submits that this information does not serve as grounds for a claim of non-use and abandonment for cancellation of RESPONDENT's mark. RESPONDENT's use of her mark by word of mouth and printing on letterhead and business cards was sufficient uses of RESPONDENT's mark for its validity. As such, this admission by PETITIONER that RESPONDENT has used the mark, albeit by word of mouth and on letterhead and business cards, is inconsistent with PETITIONER's position and negates, rather than supports, the grounds of non-use and abandonment that PETITIONER seeks to add.

PETITIONER also alleges that Mrs. Soni testified that "her operations have been geographically limited, thereby claiming that the mark was not used in interstate commerce." Again, PETITIONER distorts Mrs. Soni's testimony. Mrs. Soni testified that about ten percent of her customers came from outside of California, and include customers from several foreign countries or from international locations outside of California. See Exh. A., page 50, lines 18-25; page 51, lines 13-20. The provision of services to persons outside the state or the United States satisfies the "use in commerce" prong. Section 45(2) of the Trademark Act, 15 U.S.C. §1127, defines "use in commerce" of a

mark for services as encompassing the services "rendered in more than one State or in the United States and a foreign country."

(Emphasis added). See also, *Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834 (1998) (offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website.)

PETITIONER cannot rely upon mere allegations arising from erroneous misconstruction of Mrs. Soni's deposition testimony to its self-serving end. PETITIONER's claims are unfounded and lacking in merit.

RESPONDENT submits that if the leave to amend the Petition to Cancel is granted, undue delay will result from the need to whet those futile claims of non-use and abandonment. A need to extend discovery, and therefore delay the proceedings, supports a finding of prejudice from a delayed motion to amend a petition. See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 987 (9th Cir. 1999). Allowing amendment also will increase the cost of these proceedings for the parties and unnecessarily burden the TTAB with specious and futile claims. Accordingly, PETITIONER's motion should be denied.

///

///

#### **IV. CONCLUSION**

Based upon the foregoing law and facts, RESPONDENT Milena Soni respectfully requests the Board deny PETITIONER's motion to amend the Petition to Cancel in its entirety.

Dated: March 30, 2010

By: /s/ Ronald E. Perez  
Surjit P. Soni  
Ronald E. Perez  
Woo Soon Choe  
Attorneys for RESPONDENT,  
Milena Soni

**EXHIBIT A**

**CONFIDENTIAL DOCUMENT**

**FILED UNDER SEAL**



**CERTIFICATE OF SERVICE**

I, the undersigned, hereby certify that a true and correct copy of the foregoing document entitled **RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO FILE AMENDED PETITION TO CANCEL** was served upon the PETITIONER via USPS First-Class Mail on this 30th day of March 2010, as follows:

William Giltinan  
Carlton Fields, P.A.  
PO Box 3239  
Tampa FL 33601-3239

/s/ Lauren P. Coyle  
Lauren P. Coyle